

Remarks

Reexamination and reconsideration of this application, as amended, is requested. Claims 1-14 and 16-25 remain in the application and claim 15 has been cancelled. No new claims have been added.

Applicants believe there is no charge for this amendment because no new claims have been added.

Support for Amendments

As indicated above, the specification and claim 25 have been amended to correct a minor and inadvertent grammatical errors. This amendment is directed strictly to matters of form and, therefore, does not affect the scope of the claims or create any prosecution history estoppel.

Applicants respectfully submit that no new matter has been added.

Drawing Changes

The Office Action objected to the drawings for not including a legend such as "Prior Art." Proposed changes have been submitted as part of this response. Accordingly, Applicants respectfully request that the objection be withdrawn.

Response to the 35 U.S.C. §112, Second Paragraph, Rejection

The Office Action rejects claims 1-14 and 16-25 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action objected to the use of "substantially simultaneously and asynchronously."

Federal Courts and M.P.E.P. permit the use of "Substantially"

It is well settled that if the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise and the subject matter permits, the courts can demand no more. (See, *Georgia-Pacific Corp. v. United States Plywood Corp.*, 258 F.2d 124,136 (2d Cir.).

More importantly, Courts have recognized that the use of "substantially" in a claim does not render the claim indefinite. The Court in *U.S. Philips Corp. v. National Micronetics Inc.* stated: "Although the statute requires an exact description of the invention, it does not require description in terms of exact measurement. All that is required is that the claims, when read in light of the specifications, inform those skilled in the art how to practice the invention and how infringement may be avoided. 188 U.S.P.Q. 662.

In this case the court considered whether "substantially equal" was indefinite. The court clearly found the term to permissible and definite in view of the specification. The Court held:

"The Court finds that the term "substantially equal" as used in each claim of the patent is not so indefinite as to render the patent invalid."

M.P.E.P. § 2173.05(b) also recognizes that the use of "substantially" is permitted and does not render a claim indefinite.

With regard to claims 1-14 and 16-25, Applicants would like to kindly point out that page 8, lines 15-22, of Applicants' specification states:

"For example, a modulation circuit may include a first circuit to substantially simultaneously and asynchronously drive voltage signals onto respective voltage signal storage elements, such as capacitors, even though the voltage signals are not respectively

of opposite polarity. Likewise, instead of employing dual capacitors, a plurality of capacitors, such as more than two capacitors, may be employed. Likewise, a second circuit may be employed to sample the respective voltage signal storage elements. Of course the sampling may be performed so as to substantially maintain a substantially DC-bias, such as a substantially zero-DC bias, as previously described." (emphasis added)

Accordingly, Applicants respectively submit that one skilled in the art would understand both the scope and utilization of Applicants' invention, after reading the examples shown and described in Applicants' specification. Furthermore, Applicants respectively submit that claims 1-14 and 15-25 are, and have always been, definite. Therefore, the rejection of claims 1-14 and 16-25 is respectively traversed.

Response to the 35 U.S.C. §103(a) Rejection

The Office Action also rejects claims 1-14 and 16-25 under 35 U.S.C. §103(a) as being unpatentable over Takahara et al. (US Patent 5,436,635) in view of Shields (US Patent 4,870,396). Applicants respectfully traverse this rejection in view of the remarks that follow.

1) THE OFFICE ACTION HAS NOT ESTABLISHED A PRIMA FACIE SHOWING OF OBVIOUSNESS.

It is well established that a prima facie showing of obviousness requires a teaching or a suggestion by the relied upon prior art of all the elements of a claim (M.P.E.P. §2142). Without conceding the appropriateness of the combination, Applicants respectfully submit that the rejection is improper because the Office Action has not established a prima facie showing of obviousness of all the elements of independent claims 1, 9, 14, 18, 22, and 24.

With regard to independent claims 1, 9, 18, and 24, Applicants would like to kindly point out that each of these independent claims recites a circuit or circuit configuration to substantially and asynchronously drive respective voltage signals. In addition, claims 14 and 22 recite the step of applying signals "substantially simultaneously and asynchronously."

However, the Office Action ignored these limitations as it did not provide any explanation how the combination of Takahara et al. and Shields anticipate this feature of the claims. Instead, the Office Action is silent with regard to these limitations. Thus, Applicants can only speculate as to how the combination of Takahara et al. and Shields makes this feature of the claimed invention obvious. Furthermore, Applicants would like to kindly point out that the burden to rebut and showing of obviousness does not shift to Applicants until a prima facie showing of obviousness has been established. Since the Office Action did not provide any explanation as to how the combination makes all the features and limitations of claims 1, 9, 14, 18, 22, and 24 obvious, the Office Action has not established a prima facie showing of obviousness, and thus, the rejection is improper.

Since claims 2-8, 10-13, 16-17, 19-21, 23, and 25 depend from these claims, the Office Action has not established a prima facie showing of obviousness of these claims as well.

Conclusion

The foregoing is submitted as a full and complete response to the Office Action mailed August 2, 1999, and it is submitted that claims 1-14 and 16-25 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of claims 1-14 and 16-25 is earnestly solicited.

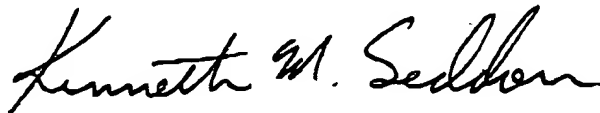
Applicants also respectfully submit that the objection to the drawings has been overcome by the suggested correction to FIGs. 4 and 7, and thus, request that the Examiner withdraw the objection to the drawings.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (480) 554-9732 is respectfully solicited.

Respectfully submitted,

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